

V. REMARKS

Claims 1 and 4-28 are rejected under 35 USC 103 (a) as being unpatentable over Matayoshi (JP 2002-035209) in view of Susumu (JP. 11-156001 A). The rejection is respectfully traversed.

In rejecting claims under 35 U.S.C. §103, the United States Patent and Trademark Office bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. "A *prima facie* case of obviousness is established if the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) quoting In re Rinehart, 531 F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (CCPA 1776). The mere fact that the prior art *may* be modified in the manner suggested by the Examiner does not make the modification *prima facie* obvious. The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led the individual to combine the relevant teachings of the references to arrive at the claimed invention. If the Examiner fails to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned.

Examiners must make appropriate rejections regarding the obviousness of claimed inventions in light of the recent Supreme Court's decision in KSR International Co. v. Teleflex Inc., 550 U.S. ___, 82 USPQ2d 1385 (2007). The familiar factual inquiries announced by the Supreme Court in its much earlier decision, Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), remain the basis for every decision regarding obviousness, i.e., Examiners will continue to consider:

- (1) the scope and content of the prior art,
- (2) the differences between the claimed invention and the prior art,

(3) the level of ordinary skill in the pertinent art, and

(4) objective evidence relevant to the issue of obviousness.

Claim 1 is directed to a gaming machine that includes a controller, a cabinet, a sound output device, a light emission device and a cover. Claim 1 recites that the controller is configured to hold an internal lottery of a game using a random number at a predetermined timing and the cabinet contains the controller and has a front surface with a recess formed thereinto. Claim 1 also recites that the recess is defined by a recess bottom wall and a stepped down wall extending generally perpendicularly to the front surface and the bottom wall. Additionally, claim 1 recites that the sound output device is disposed in the recess through the bottom wall, has a part exposed to the front surface of the cabinet of the gaming machine and is configured to output sound toward a front direction.. Claim 1 further recites that the light emission device is disposed away from the exposed part of the sound output device and is attached to the stepped down wall and the light emission device is configured to emit light. Furthermore, claim 1 recites that the cover is operative to be releasably connected to the front surface and to cover the light emission device with the cover having an internal surface and an opposite external surface with the internal surface having continuous asperities formed thereon for irregularly reflecting and diffusing the emitted light.

Claim 11 is directed to a gaming machine that includes a cabinet, a sound output device and a light emission device. Claim 11 recites that the cabinet has a front surface with a recess formed thereinto with the recess defined by a recess bottom wall and a stepped down wall extending generally perpendicularly to the front surface and the recess bottom wall. Claim 11 also recites that the sound output device is disposed in the recess through the bottom wall and has a part exposed to the front surface of the cabinet of the gaming machine and is configured to output sound toward a front direction. Further, claim 11 recites that the light emission device is disposed away from the exposed part of the sound output device and is attached to the stepped down wall with the light emission device configured to emit light.

Claim 20 is directed to a gaming machine that includes a controller, a cabinet, a sound output device, and a light emission device. Claim 20 recites that the controller is configured to hold an internal lottery of a game using a random number at a predetermined timing and the cabinet has a front surface with a recess formed thereinto with the recess defined by a recess bottom wall and a stepped down wall extending generally perpendicularly to the front surface and the recess bottom wall. Claim 20 further recites that the sound output device is disposed in the recess through the bottom wall and has a part exposed to the front surface of the cabinet of the gaming machine and is configured to output sound toward a front direction. Additionally, claim 20 recites that the light emission device is disposed away from the exposed part of the sound output device and attached to the stepped down wall with the light emission device configured to emit light.

It is respectfully submitted that that none of the applied art, alone or in combination, teaches or suggests the features of claims 1, 11 and 20. Specifically, it is respectfully submitted that the applied art, alone or in combination, fails to teach or suggest a stepped down wall extending generally perpendicularly to a front surface and a bottom wall with a light emission device being attached to the stepped down wall as recited in claims 1, 11 and 20. Thus, it is respectfully submitted that one of ordinary skill in the art could not combine the features of the applied art to arrive at the claimed invention because the applied art is devoid of all the features of the claimed invention. As a result, it is respectfully submitted that claims 1, 11 and 20 are allowable over the applied art.

Guidelines promulgated by the United States Patent and Trademark Office (Federal Register, volume 72, number 195, October 10, 2007) note that Patent Examiners must continue to explain the reasoning that leads to a legal conclusion of obviousness when rejecting claims on that ground. The reasoning may still include the established Court of Appeals for the Federal Circuit standard that a claimed invention may be obvious if the examiner identifies a prior art teaching, suggestion, or motivation (TSM) to make it. However, in keeping with the KSR decision, the guidelines explain

that there is no requirement that Patent Examiners use the TSM approach in order to make a proper obviousness rejection. Furthermore, the guidelines point out that even if the TSM approach cannot be applied to a claimed invention that the invention may still be found obvious.

To help Examiners make obviousness rejections that are supported by appropriate facts and reasoning, the guidelines identify a number of rationales suggested by the Supreme Court in the KSR decision. For each rationale, the Guidelines explain the underlying factual findings, and provide guidance about how to reason from the facts to the legal conclusion of obviousness.

Based upon the *Graham* factual inquiries, the Examiner must then articulate the following:

(1) a finding that the prior art included each element claimed although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element in the early would have performed the same function as it did separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

It is respectfully submitted that, with regard to claims 1, 11 and 20, the Examiner has failed to find that the prior art includes each claimed element as required under paragraph (1) set forth above. Specifically, as mentioned above, it is respectfully

submitted that the applied art, alone or in combination, fails to teach or suggest a stepped down wall extending generally perpendicularly to a front surface and a bottom wall with a light emission device being attached to the stepped down wall as recited in claims 1, 11 and 20.

In fact, by the Examiner's own admission, the applied art fails to teach the stepped down wall feature as recited in claims 1, 11 and 20. On Page 3, paragraph 2, in the final Office Action, the Examiner, in rejecting the claims, states:

Matayoshi discloses the LED's (40) in various locations as illustrated in Figures 5-11 but fails to disclose the LED's arranged on the stepped down wall on the speaker recess.

As asserted by the Applicants and admitted by the Examiner, none of the prior art, alone or in combination, teaches or suggests a stepped down wall extending generally perpendicularly to a front surface and a bottom wall with a light emission device being attached to the stepped down wall as recited in claims 1, 11 and 20. Therefore, it is respectfully submitted that the Examiner fails to consider all of the claim limitations, especially those that are missing from the applied art.

Further, it is respectfully submitted that since the Examiner has failed to find that the prior art includes each claimed element of claims 1, 11 and 20, paragraphs (2), (3) and (4) of the *Graham* factual inquiries set forth above cannot be satisfied. Therefore, based upon the above, it is respectfully submitted that the Examiner **cannot** support the *Graham* factual inquiries as required under **KSR**.

Furthermore, under 35 U.S.C. §103(a), a patent may not be obtained though the invention is not identically disclosed or described. . . .if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art. . . .

In re Fine, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988), the Federal Circuit held that a reference did not render the claimed combination prima facie because the Examiner ignored a material claimed temperature limitation which was absent from the reference. By analogy, the Examiner has ignored a material claimed feature, i.e., a stepped down wall extending generally perpendicularly to a front surface and a bottom wall with a light emission device being attached to the stepped down wall as recited in claims 1, 11 and 20. The Federal Circuit in this case held want of prima facie obviousness in that "the mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that the requirement is in the reference. In re Evanega, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987).

Additionally, it is respectfully submitted that the results and advantages are a part of the claimed invention as a whole. It is a basic tenet of patent law that the U.S. Patent and Trademark Office is not permitted to ignore the results and advantages produced by claimed subject matter, of which the prior art is devoid, simply because the claimed limitations are similar to that otherwise barren prior art. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988); In re Chupp, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987); Formson v. Advance Offset Plate, 755 F.2d 1549, 225 USPQ 26 (Fed. Cir. 1985). For instance, on page 4, paragraph 2, in this specification, it states:

According to the configuration, the light source of the light emission means is placed in a sideways position relative to the front of the gaming machine, so that the player is not given the impression that the light source is a light source of point light emission, and the player feels that the full face of the cover emits light. Therefore, the high illumination effect can be provided.

This result and this advantage are not taught or suggested in the applied art.

As discussed in previous responses, the subject matter of the claimed invention is to attach the LEDs inside the speaker cover so that the direction of the light source becomes parallel with the front face of the cabinet as reflected by the claim language "a light emission device... attached to the stepped down wall" as recited in claims 1, 11 and 20. The stepped down wall is a side wall of the recess and is not a bottom wall. This feature is illustrated in Figure 5 and supported in the specification on page 9, paragraph [0019] which reads, in part, as follows:

An LED board 2106e is attached to a stepped part 2110d of a recess 2110 where a part of the speaker main unit 2108 is exposed, and white LEDs 2106a to 2106d are disposed on the LED board 2106e (shown in FIG. 5). The face of the stepped part 2110d is roughly perpendicular to the front of the cabinet and the bottom of the recess 2110.

For at least the reasons discussed above, it is respectfully submitted that none of the cited references, alone or in combination, teaches or suggests this feature.

Claims 4-10 depend from claim 1 and include all of the features of claim 1. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 1 is allowable as well as for the features they recite.

Claims 12-19 depend from claim 11 and include all of the features of claim 11. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 11 is allowable as well as for the features they recite.

Claims 21-28 depend from claim 20 and include all of the features of claim 20. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 20 is allowable as well as for the features they recite.

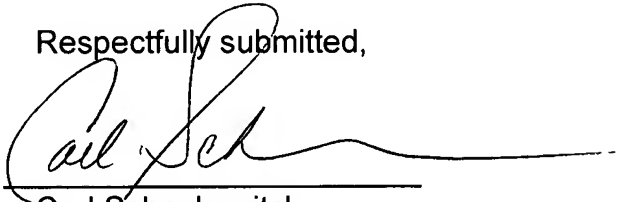
Withdrawal of the rejection is respectfully requested.

Further, Applicants assert that there are also reasons other than those set forth above why the pending claims are patentable. Applicants hereby reserve the right to submit those other reasons and to argue for the patentability of claims not explicitly addressed herein in future papers.

In view of the foregoing, reconsideration of the application and allowance of the pending claims are respectfully requested. Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

Should additional fees be necessary in connection with the filing of this paper or if a Petition for Extension of Time is required for timely acceptance of the same, the Commissioner is hereby authorized to charge Deposit Account No. 18-0013 for any such fees and Applicant(s) hereby petition for such extension of time.

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Respectfully submitted,

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